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| 10/517,730 | 08/09/2005 | William R Blackwood | DC5018 PCT 1 | 6040 |
| 137 | 7590 | 10/30/2008 | EXAMINER | |
| DOW CORNING CORPORATION CO1232 | | | OJURONGBE, OLATUNDE S | |
| 2200 W. SALZBURG ROAD | | | ART UNIT | PAPER NUMBER |
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| NOTIFICATION DATE | | DELIVERY MODE | | |
| 10/30/2008 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents.admin@dowcorning.com

| | | |
|------------------------------|--|---|
| Office Action Summary | Application No. 10/517,730 | Applicant(s) BLACKWOOD ET AL. |
| | Examiner OLATUNDE S. OJURONGBE | Art Unit 1796 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 12 September 2008.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-8 and 10-18 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-8 and 10-18 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-166/08)
 Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
 Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application
 6) Other: _____

DETAILED ACTION

Response to Amendment

1. The Amendment filed 12th September, 2008 has been entered. Claims 1-8 and 10-18 remain pending in the application.

Claim Rejections - 35 USC § 103

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

Claims 1-8 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Young et al (US 4,212,897)**.

Regarding **claim 1**, Young et al discloses a composition (Abstract, line 1) consisting:

- an organopolysiloxane containing hydroxyl groups (Abstract, lines 3-4); this serves as component (A) of the instant claim,
- a hydrolysable organic titanium compound or a partial hydrolyzate thereof (Abstract, lines 5-6); this serves as component (C) of the instant claim,

Young et al further exemplifies the components of the composition (Example XIII, col. 16, lines 45-53):

- 10g siloxane copolymer X2-5056 (col.16, lines 50-51), this serves as component (A) of the instant claim,
- 10g dimethylpolysiloxane fluid (co1.16, line 52); this serves as component (B) of the instant claim,

- 10g dimethylpolysiloxane fluid (co1.16, line 52); this serves as component (B) of the instant claim,
- 10 g tetraisopropyl titanate (co1.16, line 49); this serves as component (C) of the instant claim.

Though the organopolysiloxane containing hydroxyl groups of example XIII does not disclose RSiO₃/2 units, Young et al further discloses that the polysiloxane may be predominantly a monoorganopolysiloxane (col.2, lines 37-38); therefore, substituting the siloxane copolymer X2-5056 of example XIII with a polysiloxane that is predominantly monorganopolysiloxane (in the disclosed amount) would have amounted to nothing more than the use of a known element for its intended use in a known environment in order to achieve entirely expected result.

Regarding **claims 2-3**, modified Young et al discloses all the claim limitations as set forth above. Though Young et al does not explicitly disclose the R on the monoorganopolysiloxane being methyl, since the disclosed R on the siloxane copolymer X2-5056 (co1.16, lines 50-51) is methyl, it would have been obvious to one of ordinary skill in the art to use a monoorganopolysiloxane with methyl.

Regarding **claims 4-5**, modified Young et al discloses all the claim limitations as set forth above. The R on the disclosed dimethylpolysiloxane (co1.16, line 52) is methyl.

Regarding **claims 6-8**, modified Young et al discloses all the claim limitations as set forth above. The disclosed tetraisopropyl titanate (co1.16, line 49) conforms to the formula of the metal alkoxide of the instant claim, where M is titanium and each R⁴ is isopropyl.

10g of tetraisopropyl titanate is 100 parts per 100 part of the monoorganopolysiloxane.

Regarding **claims 10-12 and 16**, modified Young et al discloses all the claim limitations as set forth above and further discloses the composition containing 30g perchloroethylene (co1.16, line 53).

30g perchloroethylene is 300 parts per 100 part of the monoorganopolysiloxane.

Regarding **claim 13**, Young et al discloses a solution (co1.16, line 47) prepared by mixing (co1.16, line 55):

- 10g siloxane copolymer X2-5056 (co1.16, lines 50-51), this serves as component (A) of the instant claim,

- 10g dimethylpolysiloxane fluid (co1.16, line 52); this serves as component (B) of the instant claim,

- 10 g tetraisopropyl titanate (co1.16, line 49); this serves as component (C) of the instant claim.

Though the siloxane copolymer X2-5056 does not disclose RSiO₃/2 units, Young et al further discloses that the polysiloxane may be predominantly a monoorganopolysiloxane (co1.2, lines 37-38); therefore, substituting the siloxane

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copolymer X2-5056 of example XIII with a polysiloxane that is predominantly monorganopolysiloxane (in the disclosed amount) would have amounted to nothing more than the use of a known element for its intended use in a known environment in order to achieve entirely expected result.

Regarding **claims 14-15 and 18**, modified Young et al discloses all the claim limitations as set forth above and further discloses applying the composition of the invention to a large number of substrates, including wood (co1.6, lines 27-28 and co1.6, line 42).

Regarding **claim 17**, modified Young et al discloses all the claim limitations as set forth above and further discloses mixing 30g perchloroethylene (co1.16, line 53).

Response to Arguments

3. Applicant's arguments filed 12th September, 2008, have been fully considered but they are not persuasive.

Regarding the applicant's argument that all the examples taught by Young provide that the organopolysiloxane(s) are present in equal or greater amounts than the titanate, the limitations of the instant claims are met when the organopolysiloxanes and titanate of Young are in equal amount because components (A), (B) and (C) of the instant claim, which are the organopolysiloxane(s) and titanate of Young can each be present in an amount of 100 parts by weight according to the instant claim. (See instant claim 1).

Regarding the applicant's argument that the applicant's invention requires that the titanate be present in amounts greater than the organopolysiloxane of component (B), the instant claim actually emphasizes that the amount of component (C) in the composition be equal to or greater than the amount of component (B) (see instant claim 1), hence, the instant claims are rendered obvious when the amount of the titanate and the dimethylpolysiloxane fluid of Young are equal as exemplified in example XIII. Moreover, the disclosure of Young is by no means limited to the working examples. Concerning the applicant's argument about the improved stability of the present invention when the component (C) is equal to or larger than the component (B) for which the applicant refers to Tables 2 and 4, the examiner notes that while Example 30 shows an excellent stability, Examples 33 and 37 show fair stability with the components (C) and (B) being equal in all examples (see Table 4). Also, Table 3 illustrates Examples 17, 18 and 19, all with poor initial stability and good final stability, the component (C) is smaller than component (B) in 17, the component (C) is larger than component (B) in 18, and the component (C) is equal to component (B) in 19. From the results shown in the Tables above, one can conclude that there is more to obtaining desirable stability result than adjusting the amounts of components (B) and (C), therefore, the applicant's argument of improved stability when component C is equal to or larger than component (B) is not persuasive as it fails to indicate that the amount of component (C) being equal to or larger than component (B) is critical in obtaining better stability result.

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLATUNDE S. OJURONGBE whose telephone number is (571)270-3876. The examiner can normally be reached on Monday-Thursday, 7.15am-4.45pm, EST time, Alt Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571)272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

O.S.O.

/Margaret G. Moore/
Primary Examiner, Art Unit 1796
10/25/08